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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/771,522  | 02/05/2004  | Junpei Ogawa         | 023971-0371         | 3059             |
| 22428 7590 05/09/2008<br>FOLEY AND LARDNER LLP<br>SUITE 500<br>3000 K STREET NW<br>WASHINGTON, DC 20007 |             |                      |                     |                  |
|   |             |                      | EXAMINER            |                  |
|   |             |                      | LUONG, VINH         |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3682                |                  |
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|   |             |                      | 05/09/2008          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/771,522

**Applicant(s)**

OGAWA ET AL.

**Examiner**

Vinh T. Luong

**Art Unit**

3682

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 9-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 19-28 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Claim 1 is allowable. The restriction requirement of species, as set forth in the Office action mailed on January 6, 2005, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 5-8, directed to non-elected species no longer withdrawn from consideration because claims 5-8 require all the limitations of the allowable claim 1.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

2. Claim 19 is allowable. The restriction requirement between Groups I and II, as set forth in the Office action mailed on January 6, 2005, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 26-28, directed to Group II, are no longer withdrawn from consideration because claims 26-28 require all the limitations of the allowable claim 19. However, claims 9-18, directed to Group II are withdrawn from consideration because they do not require all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. This application is in condition for allowance except for the presence of claims 9-18 directed to an invention non-elected without traverse. Accordingly, claims 9-18 will be cancelled by an examiner's amendment when the case is passed to issue. See MPEP 821.02.
4. Claims 1-8 and 19-28 are allowed.
5. The drawings are objected to because:

(a) The drawings are inconsistent with the specification or *vice versa*. See 37 CFR 1.121(e). For example, Table 2 and pages 32 and 33 of the specification describe portions P and Q. However, the drawings do not show the referential character Q as required by 37 CFR 1.84(p) (5) ("Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description *must* appear in the drawings"); and

(b) Each part of the invention, such as, the lowest fatigue strength portion and the variable fatigue strength portion in claim 19 should be designated by a referential numeral or character. As noted, MPEP 608.01(g) states:

"[t]he reference characters must be properly applied, no single reference character being used for two different parts or for

a given part and a modification of such part. In the latter case, the reference character, applied to the given part, with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations. The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims.”

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The disclosure is objected to because of the following informalities: the specification is inconsistent with the drawings or *vice versa*. See 37 CFR 1.121(e). For example, Table 2 and pages 32 and 33 of the specification describe portions P and Q, however, the drawings do not show the referential character Q that indicates the portion Q as described. Appropriate correction is required.

7. Applicant's arguments filed July 5, 2005 and August 21, 2006 have been fully considered but they are **not** persuasive.

At the outset, the objections to the drawings and specification are petitionable subject matter. Therefore, the Board decision on April 29, 2008 did not address the objections set forth in the final rejection on September 22, 2005. Hence, the instant objections are remained standing. To simplify the issues, the Examiner *sua sponte* withdraws the objection to the drawings under 37 CFR 1.83(a). The objections under 37 CFR 1.84 and 1.121(e) are maintained as seen above.

With respect to Applicant's arguments on pages 10 and 11 of the Amendment filed on July 5, 2005, the Examiner's response on pages 8 and 9 in the final rejection is incorporated herein by reference. In addition, the Examiner respectfully submits that 35 USC 113 states: "[d]rawings submitted after the filing date of the application *may not* be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim." See also 37 CFR 1.81(d), MPEP 608.02, and 37 CFR 1.121(f).

8. This application is in condition for allowance except for the following formal matters: the objections to the drawings and specification above. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935). A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/  
Primary Examiner, Art Unit 3682